

DISCUSSION OF THE AMENDMENT

Due to the length of the specification herein, Applicants will cite to the paragraph number of the published patent application (PG Pub) of the present application, i.e., US 2006/0287461, when discussing the application description, both in this section and in the Remarks section, *infra*, rather than to page and line of the specification as filed.

Claim 1 has been amended by replacing reacting “a thermoplastic polyurethane” with corresponding reactants to form such a thermoplastic polyurethane, as supported in the specification at paragraphs [0025]-[0026], together with the last sentence of paragraph [0043]. Claim 3 has been canceled. Claim 5 has been amended to provide antecedent basis for a catalyst. Claims 7-9 have each been amended by inserting the word --the--. Claim 10 has been canceled.

New Claims 11-20 have been added. Claim 11 is supported at paragraph [0028]. Claims 12-14 are supported at paragraphs [0014]-[0017]. Claims 15 and 16 are supported at paragraph [0050]. Claims 17-20 are supported at paragraphs [0061]-[0062].

No new matter is believed to have been added by the above amendment. Claims 1, 2, 4-9 and 11-20 are now pending in the application.

REMARKS

The rejection of Claims 1-2 and 6 under 35 U.S.C. § 102(b) as anticipated by US 4,345,053 (Rizk et al), is respectfully traversed. Rizk et al discloses a silicon-terminated polyurethane polymer and methods for making same, which method involves forming a polyurethane prepolymer by reacting an isocyanate with a hydroxy compound used in a molar excess with respect to the isocyanate component so that the resulting reagents have hydroxy terminals, and then reacting the polyurethane prepolymer with an organosilane compound having one or more hydrolyzable alkoxy silane groups (column 1, line 64 through column 3, line 8). As supported by the examples therein, reaction to form the polyurethane prepolymer is terminated when isocyanate can no longer be detected therein.

Rizk et al neither anticipates nor otherwise renders the present claims unpatentable. In Rizk et al, the polyurethane prepolymer is formed first in which all of the isocyanate groups are reacted, followed by reaction with an isocyanato organosilane. In the present invention, on the other hand, no polyurethane prepolymer is formed. Rather, a polyurethane is formed in which the isocyanate component comprises both an isocyanate having no silane group and an isocyanato organosilane. Accordingly, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 1-3 and 6 under 35 U.S.C. § 102(b) as anticipated by US 5,990,257 (Johnston et al), is respectfully traversed. Johnston et al is similar to Rizk et al, which is described therein at column 1, lines 52-57, in that involves the silylation of a polyurethane prepolymer, wherein the invention of Johnston et al involves (A) reacting (i) a polyol component having terminal unsaturation less than 0.2 milliequivalents per gram of polyol, with (ii) a diisocyanate component at a stoichiometric excess of said polyol component to said diisocyanate component, whereby a polyurethane prepolymer is formed which is hydroxyl-terminated; and (B) reacting said polyurethane prepolymer with one or

more isocyanate silanes having a formula as described therein (paragraph bridging columns 1 and 2). Thus, Johnston et al is deficient for the same reasons as Rizk et al. Accordingly, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 4 and 7-10 under 35 U.S.C. § 103(a) as unpatentable over Rizk et al or Johnston et al, each in view of US 5,760,155 (Mowrer et al), is respectfully traversed. The Examiner relies on Mowrer et al for a suggestion of using the polyurethanes of Rizk et al or Johnston et al as a hose or cable sheath. However, even if the polyurethanes of Rizk et al and Johnston et al were used to form a hose or cable sheath, the result would still not be the presently-claimed invention. Accordingly, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 4, 7 and 10 under 35 U.S.C. § 103(a) as unpatentable over Rizk et al or Johnston et al, each in view of US 5,714,257 (Shah et al), is respectfully traversed. The Examiner relies on Shah et al as suggesting the use of the polyurethanes of Rizk et al and Johnston et al spun to give fibers. However, even if the polyurethanes of Rizk et al and Johnston et al were spun to give fibers, the result would still not be the presently-claimed invention. Accordingly, it is respectfully requested that the rejection be withdrawn.

The rejection of Claim 5 under 35 U.S.C. § 103(a) as unpatentable over Rizk et al or Johnston et al, each in view of Mowrer et al, and further in view of US 4,810,767 (Furukawa et al), is respectfully traversed. The Examiner relies on Furukawa et al as disclosing a particular catalyst. However, even if the catalyst were used to cure the polyurethanes of Rizk et al and Johnston et al, modified by Mowrer et al, the result would not be the presently-claimed invention. Accordingly, it is respectfully requested that this rejection be withdrawn.

The rejection of Claim 5 under 35 U.S.C. § 103(a) as unpatentable over Rizk et al or Johnston et al, each in view of Shah et al, and in further view of Furukawa et al, is respectfully traversed. Even if the catalyst were used to cure the polyurethanes of Rizk et al

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and Johnston et al, modified by Shah et al, the result would not be the presently-claimed invention. Accordingly, it is respectfully requested that this rejection be withdrawn.

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

The rejection of Claim 10 under 35 U.S.C. § 101 is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the rejection be withdrawn.

The rejection of Claims 5 and 10 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Indeed, the rejection would now appear to be moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the rejection be withdrawn.

Applicants respectfully call the Examiner's attention to the omission of the Examiner's initials in the box corresponding to document AW on the copy of the Form PTO 1449 for the Information Disclosure Statement (IDS) filed January 23, 2006, attached to the Office Action. The Examiner is respectfully requested to initial the Form PTO 1449 submitted therewith, and include a copy thereof with the next Office communication. A copy of the Form PTO 1449 is **submitted herewith** for the Examiner's convenience.

All of the presently-pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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